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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,569

12/21/2004

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EXAMINER

MALEK, LEILA

ART UNIT

PAPER NUMBER

2611

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,569	Applicant(s) CHRISTENSEN ET AL.	
	Examiner LEILA MALEK	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/21/04 and 06/16/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

2. The information disclosure statements submitted on 12/21/2004 and 06/16/2004 have been considered and made of record by the Examiner.

Drawings

3. The drawings are objected to because in Fig.3, blocks 296 and 295 have not been properly labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

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examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to claims 5 and 9, limitation "not indicative of said subsequent preamble of said serialized AES digital audio data" is vague.

5. Claims 4, 5, and 8, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to claims 4 and 8, limitation "fast clock pulse count" is indefinite. Because fast is a relative term and it is not clear how fast the clock pulse count is.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-8 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court

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precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example in claim 1, steps of detecting first and second transitions and determining a time separating the first and second transitions are not tied to an apparatus.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (W098/16040) (see the IDS).

As to claim 1, Adams discloses a method for extracting selected time information from a stream of serialized digital audio data (see page 3, lines 19-31 and page 4, lines 26-27), comprising: detecting a first transition indicative of a first preamble of the stream of serialized AES digital audio data (see page 3, lines 29-31, where Adams describes

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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that each preamble begins with a violation of the biphasemark encoding rule that each cell is bordered by a transition, and also see page 4, where Adams discloses that the violations have been detected (detection of violations have been interpreted as detection of a first and second preamble)); detecting a second transition indicative of a subsequent preamble of the serialized AES digital audio data; and determining a time separating the first and second transitions (see page 4, lines 26-27).

As to claim 2, Adams discloses that the determined time information is suitable for use in decoding the stream of serialized AES digital audio data (see page 1, lines 12-13).

As to claim 3, Adams discloses transferring the determined time information to a decoding logic circuit for use in decoding the stream of serialized AES digital audio data (see page 1, lines 12-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams.

As to claim 4, in view of indefiniteness of limitation “fast clock pulse count”, no patentable weight has been given to “fast”. Adams, on page 11, lines 26-28, discloses that the time information is determined in the form of a clock pulse count separating the

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first and second transitions. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Adams' background of invention as suggested in Adams' invention disclosure to allow the system to adjust the timing of the clock if necessary (see page 11, lines 28-30).

9. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, in view of Lyle et al. (hereafter, referred as Lyle) (US 7,295,578).

As to claim 6, Adams does not disclose that the determined time information is suitable for use in encoding the stream of serialized AES digital audio data. Lyle, in the same field of endeavor, discloses a communication system comprising a transmitter and a receiver (see Fig. 21), wherein a communication link between the transmitter and the receiver feeds back an audio clock signal generated at the receiver (see column 25, lines 56-57) to an encoder of the transmitter (see Fig. 29). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Adams in view of Lyle to send the clock used for decoding the data to the transmitter to synchronize the clocks used for encoding and decoding.

As to claim 7, Lyle discloses transferring the determined time information to an encoding logic circuit for use in encoding the stream of audio data (see Figs. 21 and 29 and column 25, lines 56-57). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Adams in view of Lyle to send the clock used for decoding the data to the transmitter to synchronize the clocks used for encoding and decoding.

As to claim 8, in view of indefiniteness of limitation “fast clock pulse count” no patentable weight has been given to “fast”. Adams, on page 11, lines 26-28, discloses that the time information is determined in the form of a clock pulse count separating the first and second transitions. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Adam's background of invention as suggested by Adams to allow the system to adjust the timing of the clock if necessary (see page 11, lines 28-30).

10. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. (hereafter, referred as Scott) (US 6,654,409), in view of Adams.

As to claim 10, Scott discloses an apparatus comprising: a decoder circuit (see blocks 707 and 708) coupled to receive a stream of serialized (see column 4, lines 27-28) digital audio (i.e. the telephony signal) data (see column 15, lines 24-36), the decoder circuit (combination of blocks 707 and 708) extracting time information from the stream of digital audio data during the decoding thereof; and a target component (see block 712) coupled to the decoder circuit, the target component receiving the extracted time information from the stream of serialized digital audio data; wherein the target component utilizes the extracted time information while executing at least one function (i.e. encoding) thereof (see column 15, lines 55-56). Scott discloses all the subject matters claimed in claim 10, except that the signal has been encoded according to AES standard. However, using AES standard as an encoding standard for digital audio signals is extremely well known in the art (as evidence by Adams page 1, lines 17-27) and therefore it would have been obvious to one of ordinary skill in the art at the time of

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invention to use AES standard in the system disclosed by Scott to facilitate data transmission between communication devices.

As to claim 11, Scott further discloses that the extracted time information is also utilized, by the decoder circuit, to decode the received stream of serialized digital audio data (see column 15, lines 30-32).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEILA MALEK whose telephone number is (571)272-8731. The examiner can normally be reached on 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ghayour can be reached on 571-272-3021. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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